

REMARKS

By this amendment, claim 92 has been amended. Claims 67-82, 86-89, and 92-98 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Claims 67-82, 86-89 and 98 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Forbes (US 6,377,084) in view of Nishimura et al. (US 5,013,942) and further in view of Doblar et al. (US 6,477,205). This rejection is respectfully traversed.

Applicant respectfully submits that Forbes is not a proper prior art reference under 35 U.S.C. § 103(a). The present application was filed on July 25, 2003, but claims priority to U.S. Patent No. 6,380,787, filed August 31, 1999. U.S. Patent 6,377,084 ("Forbes") was filed on February 22, 1999, and issued on April 23, 2002. As a result, Forbes qualifies as prior art only under 35 U.S.C. § 102(e). The subject matter of Forbes and of the claimed invention were, at the time the invention was made, subject to an obligation of assignment to the same entity: Micron Technology, Inc. The Assignment for this application was recorded in the PTO on August 31, 1999 on Reel 010223, Frame 0096. The Assignee of Forbes is Micron Technology, Inc., which was recorded in the PTO and appears on the face of the patent. Therefore, section 35 U.S.C. § 103(c) is applicable to the present situation.

According to MPEP § 706.02(l)(1), "[e]ffective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention 'were, at the time the invention was made, . . . subject to an obligation of assignment to the same person.'" Accordingly, Forbes is not a valid prior art reference and should be excluded under 35 U.S.C. § 103. Applicant respectfully requests that the

35 U.S.C. § 103(a) rejection of claims 67-82, 86-89 and 98 be withdrawn and the claims allowed.

Claims 92-97 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura et al. in view of Doblar et al. This rejection is respectfully traversed. Neither Nishimura et al. nor Doblar et al., even when considered in combination, teach or suggest all limitations of claim 92.

Claim 92, as amended, recites a method of synchronizing first and second operations of respective first and second circuits comprising, *inter alia*, "receiving a first signal transition at said first circuit from a first signal source through a first transmission member, said first transmission member having a first signal propagation factor and a first geometric length...; [and] receiving a second signal transition at said second circuit from a second signal source through a second transmission member, said second transmission member having a second signal propagation factor and a second geometric length..., said second geometric length different from said first geometric length" (emphasis added). Nishimura et al. does not teach or suggest this limitation.

To the contrary, Nishimura et al. teaches only a first buffer 10 providing a signal to node 5A . There is no receiving a first signal transition at a first circuit from a first signal source and receiving a second signal transition at a second circuit from a second signal source as recited in claim 92. Nor is Doblar et al. cited for this limitation. Thus, Doblar et al. does not remedy the deficiency of Nishimura et al.

Moreover, M.P.E.P. §2143 delineates the three criteria for establishing a *prima facie* case of obviousness as: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must

be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. The Office Action has failed to make a *prima facie* case of obviousness under this M.P.E.P. provision. None of the cited references contain a suggestion or a motivation for their combination. None of the references sets forth a reasonable expectation of success in their combination. The Office Action does not identify where a suggestion to combine the references exists or why a reasonable expectation of success of combining the references exists. Rather, information contained in the current application is impermissibly used, in hindsight, to pick and choose features of the references to combine to arrive at the present invention.

Since Nishimura et al. and Doblar et al. do not teach or suggest all of the limitations of claim 92, and are also not properly combinable, since motivation to do so is absent, claim 92 and dependent claims 93-97 are not obvious over the cited references. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 92-97 be withdrawn.

In view of the above, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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